

REMARKS

This Amendment is in response to the final Office Action dated August 3, 2006 and addresses the rejections included therein.

Pending Claims

The subject application was originally filed with three (3) claims. In a previous Amendment, Applicant added claims 4-8.

In the present Amendment, Applicant has cancelled claims 2, 3, 6, and 7 without prejudice to presentation of these claims, or the subject matter recited therein, in this or a later filed case. Applicant has also added newly presented claims 9 and 10. Upon entry of this Amendment, claims 1, 4, 5, and 8-10 will be pending in the subject application.

Summary of Office Action

In the final Office Action dated August 3, 2006, the Examiner:

- (1) rejected claims 1-8 under 35 U.S.C. § 112, second paragraph, as being indefinite; and
- (2) rejected claims 1-8 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-11 of U.S. Patent No. 6,691,403 (“the ‘403 patent”)¹.

Annotated Version of Amended Claim 1

Pursuant to the Examiner’s request, Applicant has provided below an annotated version of amended claim 1 that includes reference numerals in parentheses after each element:

1. A tool (10) for cutting and stripping a sheath (12) from an electrical cable (14), the electrical cable (14) having a spaced pair of insulated power conducting wires (16), a ground wire (18) disposed between the power conducting wires (16), and the sheath (12) surrounding the power conducting (16) and ground (18) wires, the sheath (12) having a pair of spaced side portions (12A) that contain the power conducting wires (16) and a

¹ The Office Action states that the 35 U.S.C. § 101 rejection is based on U.S. Patent No. “09/185,493.” This number is actually the serial number for U.S. Patent No. 6,691,403. In light of this, Applicant will treat this rejection as if it said that the rejection was based on U.S. Patent No. 6,691,403.

central portion (12B) disposed therebetween that contains the ground wire (18), the tool (10) comprising:

- a) a pair of levers (30,32) having jaw (38,40), boss and handle (34,36) portions, each handle (34,36) portion having an insulated cover (52);
- b) a pivot (42) joining the boss portions to enable relative movement of the levers (30,32) about the pivot (42) between open and closed positions;
- c) the jaw portions (38,40) each having blade sections (24C,26C) for coactively circumferentially severing the sheath (12) when the levers (30,32) are moved from the open to the closed position;
- d) each blade section (24C,26C) having a set of three aligned cutting parts of a cutting edge (24,26), the set of three cutting parts including a spaced pair of end cutting parts (24A,26A) being contoured to cut the side portions (12A) of the sheath (12) and a raised middle cutting part (24B,26B) between the end cutting parts (24A,26A) for cutting the central portion (12B) of the sheath (12), wherein the raised middle cutting part (24B,26B) is arcuate with end portions curving toward a longitudinal axis (B) of the tool (10); and
- e) the cutting parts together forming a cable wire receiving opening (54) when the levers (30,32) are in the closed position, the cable receiving opening (54) being of a configuration smaller than the configuration of the sheath (12), such that the sheath (12) is circumferentially severed when the levers (30,32) are moved from the open to the closed position.

Annotated Version of Amended Claim 5

Pursuant to the Examiner's request, Applicant has provided below an annotated version of amended claim 5 that includes reference numerals in parentheses after each element:

5. A tool (10) for cutting and stripping a sheath (12) from an electrical cable (14), the electrical cable (14) having a spaced pair of insulated power conducting wires (16), a ground wire (18) disposed between the power conducting wires (16), and the sheath (12) surrounding the power conducting (16) and ground (18) wires, the sheath (12) having a

pair of spaced side portions (12A) that contain the power conducting wires (16) and a central portion (12B) disposed therebetween that contains the ground wire (18), the tool (10) comprising:

- a) a pair of levers (30, 32) having jaw (38,40), boss and handle (34,36) portions, each handle (34) portion having an insulated cover (52);
- b) a pivot (42) joining the boss portions to enable relative movement of the levers (30, 32) about the pivot (42) between open and closed positions;
- c) the jaw portions (38,40) each having blade sections (24C, 26C), each blade section (24C, 26C) having a set of three aligned cutting parts of a cutting edge (24, 26), the three cutting parts including a spaced pair of end cutting parts (24A, 26A) configured to at least partially cut through the side portions (12A) of the sheath (12), and a raised middle cutting part (24B, 26B) provided between the end cutting parts (24A, 26A) and configured to cut the central portion (12B) of the sheath (12), wherein the raised middle cutting part (24B, 26B) is substantially straight and substantially parallel with respect to a longitudinal axis (B) of the tool (10); and
- d) the cutting parts on each blade section together forming a cable receiving opening (54) when the levers (30, 32) are in the closed position, the cable receiving opening (54) is sized such that, when the levers (30, 32) are moved from the open to the closed position, the perimeter of the sheath (12) is cut.

Rejection of Claims 1-8 under 35 U.S.C. § 112, Second Paragraph

Applicant does intend to claim the subcombination alone – the tool. The references to an “electrical cable,” “a sheath,” etc. are merely recited to provide the environment in which the tool is used. In the previous Amendment dated May 22, 2006, Applicant amended claim 1 to clarify its intent and included similar language in the preamble of independent claim 5. In light of the foregoing, Applicant requests that the rejection of claims 1-8 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Rejection of Claims 1-8 under 35 U.S.C. § 101

Regarding the Examiner's rejections of claims 1-8 under 35 U.S.C. § 101, Applicant has amended independent claims 1 and 5 to include several limitations not recited in claims 1-11 of the '403 patent. Specifically, Applicant has amended independent claims 1 and 5 to include limitations that the handle portion has "an insulated cover" and that "the raised middle cutting part is arcuate with end portions curving toward a longitudinal axis of the tool." Based on these amendments to independent claims 1 and 5, Applicant requests that the Examiner withdraw the double patenting rejection based on 35 U.S.C. § 101.

New Claims

As discussed above, Applicant has added newly presented claims 9-10. Independent claim 9 tracks independent claim 1, with the exception that it includes an insulated coating instead of an insulated cover and a raised middle cutting part that is substantially straight and substantially parallel with respect to a longitudinal axis of the tool, rather than one that is arcuate with end portions curving toward the longitudinal axis of the tool.

Applicant submits that these new claims do not introduce new matter as they are supported by the specification and drawings of the subject application. Additionally, consideration of these new claims should not require an additional search. Applicant submits that new claims 9 and 10 are patentable in light of the prior art of record for the same reasons as discussed above.

Conclusion

In view of the remarks above and the amendments presented herein, it is believed that claims 1, 4, 5, and 8-10 are in condition for allowance and notice to such effect is respectfully requested. If the Examiner thinks a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at the phone number provided below.

The Commissioner is hereby authorized to charge any necessary additional fees, or credit any overpayment, to Deposit Account No. 02-2051, referencing Docket No. 24685-113.

Respectfully submitted,

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